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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/670,067	09/23/2003	Walter Odoni	DT-6626	5091
30377	7590	12/29/2005	EXAMINER	
DAVID TOREN, ESQ. ABELMAN FRAYNE & SCHWAB 666 THIRD AVENUE NEW YORK, NY 10017-5621			HARRIS, KATRINA B	
			ART UNIT	PAPER NUMBER
			3747	

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/670,067	ODONI ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	Katrina B. Harris	3747

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1)  Responsive to communication(s) filed on 23 September 2003.

2a)  This action is **FINAL**.                    2b)  This action is non-final.

3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-16 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5)  Claim(s) \_\_\_\_\_ is/are allowed.

6)  Claim(s) 1-3,7-11,15 and 16 is/are rejected.

7)  Claim(s) 4-6 and 12-14 is/are objected to.

8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_ .  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_

## **DETAILED ACTION**

The following is a first action on the merits of application serial no. 10/670,067 filed September 23, 2003.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 and 7-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Phillips et al. (6,019,072)

Phillips et al. discloses a combustion-engine setting tool (10) for driving fastening elements in a constructional component, comprising a combustion chamber (126), a fuel source (77), a fuel conduit for connecting the fuel source (77) with the combustion chamber (126), at least one metering device arranged in the fuel conduit () for metering

out a predetermined amount of fuel in form of a n- number of discrete separate portions, with a preset volume of each separate portion remaining constant and a control device (20) for actuation of the metering device (70).

Regarding claim 2, a setting tool according to claim 1, further comprising sensor means for determining parameters of the setting tool and of the environment and for communicating acquired data to the control device (), whereby the control device () determines, for each operation cycle, the n-number based on the determined parameters of the setting tool and the environment.

Regarding claim 3, a setting tool according to claim 1, further comprising a counter flow meter (70) associated with the metering device (128) for determining volumes of metered-out fuel and for transmitting acquired data to the metering device (21) for adjusting a set value of the n-number.

Regarding claim 7, wherein the counter (70) is formed as an integrated flow meter.

Regarding claim 8, wherein the counter (70) is formed as a step counter.

Regarding claim 9, wherein sensor means comprises sensors for determining air pressure, temperature, and air humidity of surrounding the setting tool, air.

Regarding claim 10, wherein the metering device is actuated by a solenoid.

Regarding claim 11, wherein the solenoid acts on the displaceable body.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 7-11, 15 and 16 are alternately rejected under 35 U.S.C. 102(e) as being anticipated by Odoni et al. (6,722,548).

Odoni et al. discloses a combustion-engine setting tool for driving fastening elements in a constructional component, comprising a combustion chamber (13), a fuel source (11), a fuel conduit for connecting the fuel source (11) with the combustion chamber (13), at least one metering device arranged in the fuel conduit (12) for metering out a predetermined amount of fuel in form of a n- number of discrete separate portions, with a preset volume of each separate portion remaining constant and a control device (20) for actuation of the metering device (30).

Regarding claim 2, a setting tool according to claim 1, further comprising sensor means for determining parameters of the setting tool and of the environment and for communicating acquired data to the control device (), whereby the control device () determines, for each operation cycle, the n-number based on the determined parameters of the setting tool and the environment.

Regarding claim 3, a setting tool according to claim 1, further comprising a counter flow meter (21) associated with the metering device (128) for determining volumes of metered-out fuel and for transmitting acquired data to the metering device (21) for adjusting a set value of the n-number.

The applied reference has a common inventors with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

#### ***Allowable Subject Matter***

Claims 4-6 and 12-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Communication***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katrina B. Harris whose telephone number is 571-272-4842. The examiner can normally be reached on 6:00 AM -2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Yuen can be reached on 571-272-4856. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Katrina B. Harris  
Examiner  
Art Unit 3747

KBH

  
Andrew M. Dolinar  
Primary Examiner